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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

NOKM.011PA

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on August 22, 2006Signature Rennae JohnsonTyped or printed name Rennae Johnson

Application Number

09/919,317

Filed

07/31/2001

First Named Inventor

JOKINEN

Art Unit

2683

Examiner

Torres, M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 37,830
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

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August 22, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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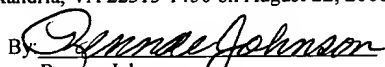
SERIAL NO. 09/919,317

PATENT APPLICATION

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Jokinen et al. Examiner: Torres, M.
Serial No.: 09/919,317 Group Art Unit: 2683
Filed: July 31, 2001 Docket No.: NOKM. 011PA
Title: System and Method for Automatic Provisioning Detection and Notification

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 22, 2006.

By: 
Renrae Johnson

**APPELLANT'S STATEMENT IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is presented by Appellant in compliance with the USPTO OG Notice of 12 July 2005 on New Pre-Appeal Brief Conference Pilot Program. Appellant is requesting a pre-appeal brief conference on the belief that the rejections of record are clearly not proper and are without basis. Appellant's request is based upon a clear legal or factual deficiency in the rejections, rather than an interpretation of the claims or the prior art teachings. As such, Appellant believes this request for pre-appeal brief review is appropriate.

Claims 1, 3, 4, 7-11, 19-22, 24, 28, 29 and 45-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,615,038 by Moles *et al.* (hereinafter "Moles") in view of U.S. Patent No. 5,809,413 by Meche *et al.* (hereinafter "Meche"). The remaining dependent claims are rejected under 35 U.S.C. §103(a) at least in part on the basis of the above combination or in view of Moles in combination with other references.

While Appellant has multiple issues for *appeal*, the primary purpose for submitting this particular *request for review* concerns omissions of essential elements needed for a *prima facie*

rejection. Each rejection in the final Office Action (dated March 23, 2006) involves the Moles reference and relies on the Moles reference as teaching all, or a substantial portion, of each of the claims.

The limitations at issue for purposes of this request for review relate to providing a notification to a provisioning server to initiate the provisioning procedures for an unprovisioned terminal in response to the automatic detection of the unprovisioned terminal. To establish a *prima facie* §103(a) rejection, these limitations must be present in Moles, as the Examiner alleges.

In support of this allegation, the Examiner cites three portions of Moles (column 6, lines 28-39; column 8, lines 26-65; and column 7, lines 12-17). None of these portions teaches providing a notification to initiate provisioning procedures. In the “Response to Arguments” in the final Office Action at the bottom of page 2, the Examiner notes that Appellant has argued that Moles fails to teach these limitations and asserts that Moles discloses sending a notification to the server with configuration data. Each of the cited portions indicates that configuration data is gathered: “[e]ither during the service provisioning or at a subsequent time” (column 6, lines 33-34); “during the time that each handset is being provisioned or at a subsequent time” (column 7, lines 16-17); and “[d]uring or subsequent to service provisioning for MS 112” (column 8, lines 31-32). Any alleged notification regarding configuration data in Moles is sent during or subsequent to provisioning, and thus, cannot be a notification to initiate the provisioning procedures, as claimed.

It is respectfully submitted that there is an omission of an essential element needed for a *prima facie* rejection. Moles does not involve or describe providing a notification to a provisioning server to initiate the provisioning procedures for an unprovisioned terminal in response to the automatic detection of the unprovisioned terminal, and neither the cited portions nor Moles in general describe this. Moles is solely relied upon in each of the §103(a) rejections as teaching these claimed features. Because Moles does not involve or otherwise address providing a notification to a provisioning server to initiate the provisioning procedures for an unprovisioned terminal, Appellant believes these claim limitations are improperly being overlooked, and consequently there is an omission of an essential element(s) needed for a *prima facie* rejection.

It is Appellant's position that the Examiner's reliance on Moles in each of the §103(a) rejections as teaching providing a notification to a provisioning server to initiate the provisioning procedures for an unprovisioned terminal is inappropriate, as Moles does not address this.

Appellant believes that this statement, when viewed together with the prosecution history, sets forth clear grounds for a finding that the rejections based upon Moles are improper and without basis.

The undersigned is of record and with authority to prosecute the appeal on behalf of the Assignee.

Respectfully submitted,

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